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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

200315774-1

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on

1/18/07

Signature

Typed or printed name

Desiree Reardon

Application Number

10/737,106

Filed

12/15/03

First Named Inventor

Gerald L. EVERETT

Art Unit

2189

Examiner

Choi, W. H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

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applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Remarks Accompanying Pre-Appeal Brief Request For Review

In response to the final Office Action dated October 10, 2006, Applicants respectfully request a review of the final rejection in the above identified application.

Applicants respectfully submit that the Examiner's rejection of Claims 2-4 and 13 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention is improper.

Applicants also respectfully submit that the Examiner's rejection of Claims 1-3, 8-14 and 18-22 under 35 U.S.C. 102(e) as being anticipated by Cepulis is improper as an essential element for a proper rejection is missing (e.g., the teaching of all of the recited claim limitations).

Applicants also respectfully submit that the Examiner's rejection of Claims 1, 8 and 18 under U.S.C. 102(e) as being anticipated by Malek is improper as an essential element for a proper rejection is missing (e.g., the teaching of all of the recited claim limitations).

Applicants also respectfully submit that the Examiner's rejection of Claims 5-7, 15-17 and 23-25 under 35 U.S.C. 103(a) as being unpatentable over Malek in view of

Fish is improper as an essential element for a proper rejection is missing (e.g., the teaching of all of the recited claim limitations).

### Rejection of Claims Under 35 U.S.C. 112

Claims 2-4 and are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants submit that the rejection of Claims 2-4 under 35 U.S.C 112, second paragraph is improper because there is sufficient antecedent basis for the limitation “said system call requesting said memory allocation.”

In the response to arguments portion of the current Office Action, the Examiner states that the limitation “receiving a system call for a system firmware feature” is not antecedent basis for “returning a response to said system call requesting said memory allocation” because there is no recitation of “a system call requesting” any memory allocation prior to the limitation in question. Applicants respectfully assert that this rejection is improper because the Applicants have fulfilled the requirements for providing antecedent basis for the limitation in question.

### REJECTION DOES NOT SATISFY REQUIREMENTS OF A *PRIMA FACIE* CASE OF ANTICIPATION

**“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”**  
**/Verdegaal Bros. v. Union Oil Co. of California/, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The identical invention must be shown in as complete**

**detail as is contained in the ... claim.” /Richardson v. Suzuki Motor Co./, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.**

**KEY CLAIM LIMITATIONS THAT ARE NOT MET BY THE CITED ART**

Claim 1 sets forth a computer implemented method for establishing a run-time data area comprising:

relocating a firmware module from a read-only memory location to a writeable memory location during a system boot-up operation;

reserving a portion of said writeable memory location comprising a memory allocation for said firmware module and an additional memory allocation; and

designating said additional memory allocation as said run-time data area, wherein said run-time data area is created without requiring prior knowledge of system resource allocation.

**Rejection of Claims Under 35 U.S.C. 102**

In the current Office Action, the Examiner makes reference to Cepulis supporting the grounds of rejection. However, Applicants do not understand Cepulis to teach or suggest “relocating a firmware module from a read-only memory location to a writeable memory location during a system boot-up operation,” as claimed in Independent Claim 1. Independent Claims 8 and 18 recite similar limitations. In paragraph 17, Cepulis teaches “the computer system may have the capability of logically partitioning the computer resources and then executing multiple operating systems, one in each partition.” This is very different from “relocating a firmware module from a read-only memory location to a writeable memory location during a system boot-up operation,” as claimed.

For this rational, Cepulis does not teach each and every element of Independent Claims 1, 8 and 18. Therefore, the rejection of Claim 1-4, 8-14 and 18-22 under 35 U.S.C. 102(e) as being anticipated by Cepulis is improper and should be reversed.

In the current Office Action, the Examiner makes reference to Malek supporting the grounds of rejection. However, Applicants do not understand Malek to teach or suggest “relocating a firmware module from a read-only memory location to a writeable memory location during a system boot-up operation,” as claimed. Malek purports to teach in column 2, lines 33-40 “the present invention provides a process and means for enumeration of multiple devices/functions on a riser card.....This is accomplished by creating a virtual add-on ROM that the BIOS will detect naturally.”

Malek further teaches in 404 of Figure 4 “ROM contents are shadowed into main memory.” Shadowing contents is very different from “relocating a firmware module from a read-only memory location to a writeable memory location during a system boot-up operation,” as claimed. With the present invention, the firmware is relocated and not shadowed, as with Malek. For this rational, the rejection of Claims 1, 8 and 18 under U.S.C. 102(e) as being anticipated by Malek is improper and should be reversed.

#### Rejection of Claims Under 35 U.S.C. 103

The rejection of Claims 5-7, 15-17 and 23-25 under U.S.C. 103(a) as being unpatentable over Malek in view of Fish is improper because key claim limitations are not met by the cited references. Specifically, neither Malek nor Fish teach or suggest

“relocating a firmware module from a read-only memory location to a writeable memory location during a system boot-up operation,” as claimed.

Specifically, Fish fails to teach or suggest “relocating a firmware module from a read-only memory location to a writeable memory location during a system boot-up operation,” as claimed. For this rational, the rejection of Claims 5-7, 15-17 and 23-25 as being unpatentable over Malek in view of Fish is improper and should be reversed.

In summary, Applicants respectfully submit that the Examiner’s rejections of the Claims are improper as the rejection of Claims 1-3, 8-14 and 18-22 under 35 U.S.C. 102(e) as being anticipated by Cepulis does not satisfy the requirements of a prima facie case of anticipation as claim limitations are not met by the cited reference. Moreover, Applicants respectfully submit that the Examiner’s rejection of the Claims is improper as the rejection of Claims 1, 8 and 18 under U.S.C. 102(e) as being anticipated by Malek does not satisfy the requirements of a prima facie case of obviousness as claim limitations are not met by the cited reference. Furthermore, the rejection of Claims 5-7, 15-17 and 23-25 under 35 U.S.C. 103(a) as being unpatentable over Malek in view of Fish does not satisfy the requirements of a prima facie case of anticipation as claim limitations are not met by the cited references. Accordingly, Applicants respectfully submit that the rejection of Claims 2-4 and 13 under 35 U.S.C. 112, second paragraph, the rejection of Claims 11-3, 8-14 and 18-22 under 35 U.S.C. 102(e), the rejection of Claims 1, 8 and 18 under U.S.C. 102(e) and that the rejection of Claims 5-7, 15-17 and 23-25 under 35 U.S.C. 103(a) are improper and should be reversed.